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Patricia Zimmerman - Enri
(Signature)
July 18, 2003
(Date of Signature and Deposit)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of : Trademark Law Office: 112
Modern Builders Supply, Inc. :
Serial No. 78/062,671 : Trademark Attorney:
Filed: May 9, 2001 : Tonja M. Gaskins
For: ENERGYWELD : Attorney Docket 1-23130

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BRIEF FOR APPELLANT

Introduction

Applicant hereby appeals from the Examining Attorney's refusal to register the above-identified mark dated December 2, 2002, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

Applicant's Trademark

Applicant seeks registration on the Principal Register of its mark:

ENERGYWELD

for non-metal windows and doors.

JA

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Prior Registrations Cited by the Examiner

None.

The Rejection

The Examining Attorney has refused registration of Appellant's mark because the specimen submitted with the Statement of Use does not show use of the proposed mark in connection with the identified goods. (Office Action Mailed July 1, 2002).

In the Office Action mailed December 2, 2002, the Examining Attorney further expounded her position contending that the specimen is still unacceptable as evidence of actual trademark use. The Examining Attorney states:

Although the mark is shown on a label and that label is shown on a window, the mark is not used in connection with that window. Instead the mark appears among a list of applicant's marks that are used in connection with other products. The list of marks follows a statement that directs the purchaser of the window to "Look for these other fine Polaris products...." There is no connection between the proposed mark and the actual window upon which the label appears. The specimen label simply acts as advertising material for the proposed mark.

The Issue

The sole issue presented by this appeal is whether the specimen submitted with the Statement of Use is acceptable under Sections 2.56 and 2.88(b)(2) of the Trademark Law Revision Act.

Argument

I. APPELLANT'S SPECIMEN DOES MEET THE REQUIREMENTS ACCORDING TO THE TRADEMARK STATUTES AND RULES.

The Examining Attorney has committed error in contending that the specimen submitted with the Statement of Use does not show use of the proposed mark in connection with the identified goods and that there is no connection between the proposed mark and the actual window upon which the label appears.

The specimen submitted with the Statement of Use is a label that is affixed to all windows and doors or their packaging manufactured by Polaris Technologies. Polaris Technologies is the window and door manufacturing division of the Appellant. The registered trademark Polaris referred to on the label is Appellant's house mark for its window and door line while the other trademarks shown on the label are secondary product marks. Appellant made of record (Response filed October 10, 2002) two digital photographs, one showing an entire window that is wrapped for shipping bearing the label submitted with the Statement of Use, the second showing a closer view of the label on the wrapped window. 15 U.S.C. §1127 provides that "a mark shall be deemed to be in use in commerce (A) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto...".

The Examining Attorney has erroneously contended there is no connection between the proposed mark and the actual window upon which the label appears and that the specimen label simply acts as advertising material for the proposed mark. The specimen label includes installation instructions for all Polaris windows and patio doors and is not merely advertising material for the proposed mark. The Appellant's mark ENERGYWELD is prominently displayed on the specimen label that is placed on the

goods or their packaging when the goods are sold or transported in commerce. At the very least, prominent display of the Appellant's mark ENERGYWELD on the specimen label which is placed on the goods or their packaging when sold or transported in commerce is a display associated with the goods and meets the requirements for demonstrating use of a mark in commerce within the meaning of the Lanham Act.

Accordingly, it is the Appellant's contention that the specimen label meets the requirements according to the trademark statutes and rules and supports use in commerce of the mark covered by the present application.

Conclusion

For the reasons set forth above, Appellant submits that the specimen submitted with the Statement of Use is acceptable within the meaning of Section of the Trademark Law Revision Act. Accordingly, Appellant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's mark.

Respectfully submitted,

Date: July 18, 2003

Oliver E. Todd, Jr.

Attorney for Appellant

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